

REMARKS

In the Office Action, the Examiner allowed claims 6-11 and 13. The Examiner rejected claims 1, 2, and 12 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,201,968 to Ostroff et al. ("Ostroff"); rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of U.S. Patent No. 5,854,981 to Wallstedt et al. ("Wallstedt"); and rejected claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of U.S. Patent No. 6,112,089 to Satarasinghe ("Satarasinghe").¹

By this Amendment, Applicants amend claims 1 and 12. Claims 1-13 remain currently pending. Applicants thank the Examiner for allowing claims 6-11 and 13. Applicants respectfully traverse the Examiner's rejections under both § 102 and § 103.

Regarding claim rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, and 12 under 35 U.S.C. § 102(b) as being anticipated by Ostroff. In order to anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Independent claim 1, as amended, recites a combination including, for example, “a circuit configured to select, as a hand-off destination candidate, one station from the first plurality of peripheral base stations indicated in the first neighbor list and the second plurality of peripheral base stations indicated in the second neighbor list, which satisfies a preset condition, based on the measured communication quality, wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station.” Ostroff fails to disclose at least the claim elements listed above as recited in amended claim 1.

Ostroff teaches “[w]hen the subscriber unit (405) obtains a new neighbor cell list (442) from the cell site (428), it determines whether characteristics of the cell site (428) is such that the new neighbor cell list (442) does not adequately reflect available neighboring cell sites. . . . In such cases, the subscriber unit combines entries from its current neighbor cell list (451) with entries from the new neighbor cell list (442) obtained from the cell site to generate a supplemented neighbor cell list (652).” Ostroff, abstract, emphasis added. However, Ostroff fails to disclose at least “wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station,” as recited in amended claim 1 (emphasis added).

Therefore, Ostroff fails to disclose each and every element of amended claim 1. Ostroff thus cannot anticipate amended claim 1 under 35 U.S.C. § 102. Accordingly, Applicants respectfully request withdrawal of the Section 102 rejection of amended claim 1. Because claim 2 depends from claim 1, Applicants also request withdrawal of the Section 102 rejection of claim 2 for at least the same reasons stated above.

Further, amended independent claim 12, while of different scope, recites similar language to that of claim 1. Claim 12 is therefore also allowable for at least the same reasons as stated above with respect to claim 1. Applicants also respectfully request withdrawal of the Section 102 rejection of claim 12.

Regarding claim rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Wallstedt, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

As set forth above, Ostroff fails to teach or suggest "wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station," as recited in amended claim 1 and required by claim 3.

Wallstedt fails to cure Ostroff's deficiencies. The Examiner alleges that "WALLSTEDT discloses wherein a memory stores a neighbor list for a preset time (col. 15, lines 23-col. 16, lines 2; col. 18, lines 8-48; memory updates the neighbor list according to a predetermined time)." (Office Action at 5.) Even assuming the Examiner's allegation is true, which Applicants do not concede, Wallstedt fails to teach

or suggest at least the above listed claim elements as recited in amended claim 1 and required by claim 3.

Therefore, neither Ostroff nor Wallstedt, taken alone or in any reasonable combination, teaches or suggests all elements required by claim 3. A *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claim 3.

Applicants also respectfully traverse the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Ostroff in view of Satarasinghe. Claims 4 and 5 depend from claim 1. Satarasinghe also fails to cure Ostroff's deficiencies including its failure to teach at least "wherein the first neighbor list and the second neighbor list are used without determining characteristics of the serving base station," as recited in amended claim 1 and required by claims 4 and 5.

The Examiner alleges that "SATARASINGHE discloses wherein the pilot signal reception quality is measured (column 2:lines 25-45)" and "SATARASINGHE discloses wherein the neighbor list is obtained by excluding the first peripheral base stations doubly listed as the second peripheral base stations in the second neighbor list (Figures 2 and 3; column 3:lines 16-67)." (Office Action at 6-7.) Even assuming the Examiner's allegation is true, which Applicants do not concede, Wallstedt fails to teach or suggest at least the above listed claim elements as recited in amended claim 1 and required by claims 4 and 5.

Therefore, neither Ostroff nor Satarasinghe, taken alone or in any reasonable combination, teaches or suggests all elements required by claims 4 and 5. A *prima*

facie case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the Section 103(a) rejection of claims 4 and 5.

Conclusion

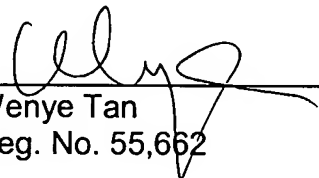
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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